



2232-163

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/028,331
Applicant : G. DANILOFF, et al.
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Examiner : Gary W. Counts

Docket No. : 2232-163
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RESPONSE TO RESTRICTION REQUIREMENT

Director of the United States Patent
and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

This is in response to the Restriction Requirement mailed April 5, 2004 in the above-identified application.

First, applicants elect the invention of Group I, claims 1-23.

With respect to the requirement for election of species, it seems to be based on the assumption that each combination of ligand element (from claim 9) and species of indicator (from claim 23) is unrelated to the others. That is incorrect. As is clear from the specification, the claimed structures have a common function, i.e., they are useful in detecting the presence or concentration of a polyhydroxyl analyte in a sample.

The restriction requirement relies on MPEP §§806.04 and 808.01, but those sections do not support the requirement. For

example, §806.04 (A) contains the language used in the requirement (inventions independent if "not disclosed as capable of use together," etc.) but the further elaboration contained in that section shows that that section has no applicability to the present claims. That section gives two examples of independent inventions: i) a shoe and a locomotive bearing; and ii) a process of painting a house and a process of boring a well. Because all of the claimed inventions are directed to methods for detecting the presence or concentration of a polyhydroxyl analyte in a sample, MPEP §806.04 does not support the Examiner's position.

MPEP §808.01 likewise does not support the restriction requirement. That section repeats the "not connected in design, operation or effect" standard (which as shown above has no applicability to the present claims).

It is additionally noted that claim 1 is a claim generic to all species of claims 9 and 23. Therefore, even if the Examiner were correct, applicants would be entitled to maintain claims to multiple species if the generic claim were found allowable. 37 CFR §1.141(a).

Without waiving the foregoing, applicants elect the optionally substituted vicinal hydroxy-containing compound species of claim 9, and the N-(5-methoxycarbonyl-5-[3,4-dihydroxybenz-amido]pentyl)-N'-(5-fluoresceinyl)thiourea indicator species of claim 23. The elected claim 23 indicator

species is depicted on page 39 of the specification, upper left structure (fluorescene-catechol adduct).

Respectfully submitted,



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